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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,275	11/26/2003	Douglas Allard	11533.0028.NPUS00	8914

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EXAMINER	
CECIL, TERRY K	

ART UNIT	PAPER NUMBER
1723	

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/724,275	ALLARD, DOUGLAS	
	Examiner	Art Unit	
	Mr. Terry K. Cecil	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-10,12-19,21-30,32 and 34-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-10,12-19,21-30,32 and 34-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *6-5-2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4-7, 10, 12-16, 19, 22-23, 25-26, 28-30 and 33-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker (U.S. 971,578). Walker teaches a downspout filter apparatus. The apparatus is considered by the examiner to include pipes 16, 19 and 6 (19 and 16 are joined by 15) connected between an inlet 1 and a plurality of outlets. A plurality of filters are disclosed including 11, 9, 8, & 18. Flow paths 16 and 19 are considered to be primary and secondary bypasses providing alternate routes through the apparatus. Each pipe is disclosed to provide either drinking water or water for other uses (separate destinations). See page 2, lines 35-47. *Walker teaches at least one filter basket 11.*

3. Claims 1, 3, 5-7, 10, 14-15, 18-19, 21, 23-24, 29-30, 32, 36 and 39-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Minnemeyer.

Minnemeyer teaches a filter in a downspout from an eave. A diverter A^3 directs the filtered rainwater either to the outlet or to a second outlet leading to a cistern. As shown in the drawings the rest of the limitations of the aforementioned claims are met. *Because of the diverter a bypass exists that bypasses the first outlet in favor of the second (both will be filtered).*

Claim Rejections - 35 USC § 102/103

10. Claims 8-9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over any of the above prior art reference. The reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although produced by a different process. The way in which the filter apparatus is added to the downspout—e.g. cutting out a section of pipe and replacing with apparatus—is a product-by-process limitation. The examiner contends that the result produce is the same as those known above and at least on obvious variant thereof. See In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) and In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP § 2113.

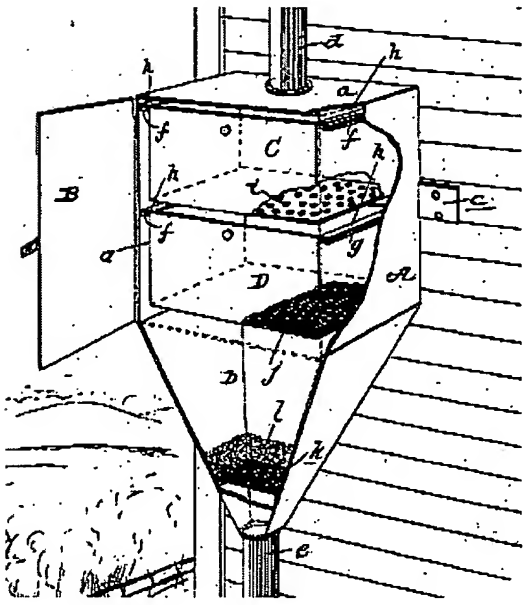
Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.



5. Claims 1, 3-7, 10-12, 14-16, 19, 21-23, 25-26, 28-30, 32, 34-37 and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley (U.S. 0,543,922) in view of Walker.

Buckley teaches a downspout filter apparatus that discloses all the limitations of claims 1-7, 10, 19-23 and 29-32 including a plurality of filters each having filter elements or screens. Filters Drawers C and D are considered by the examiner to be "cartridges". An outer housing A is provided about the cartridges. In operation, rainwater from a downspout is filtered while flowing through the plurality filters and the filtered water returns to the downspout [as in claims 40-43]. Buckley doesn't teach a bypass through the apparatus but such is taught by Walker, as explained above. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the bypass of Walker in the invention of Buckley since Walker, teaches the benefit of either directing the rainwater into a sewer to carry off the dirt and impurities collected on the roof or directing to a cistern for household use (col. 1).

12. Claims 17, 27 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of the above prior art references in view of Macpherson et al. (U.S. 6,821,427). These claims add the limitation of chitosan. Macpherson teaches a chitosan gel for treating stormwater. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the chitosan of Macpherson in any of the aforementioned downspout filters, since Macpherson teaches the benefit of reducing the amount of contaminants in stormwater.

Response to Arguments

6. Applicant's arguments filed 6-5-2006 have been fully considered but they are not persuasive. Despite applicant's remarks to the contrary both Minnemeyer and Walker teach a bypass and a filter basket.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Contact Information:

- Examiner Mr. Terry K. Cecil can be reached at (571) 272-1138 at the Carlisle campus in Alexandria, Virginia for any inquiries concerning this communication or earlier communications from the examiner. Note that the examiner is on the increased flextime schedule but can normally be found in the office during the hours of 8:30a to 4:30p, on at least four days during the week M-F.
- Wanda Walker, the examiner's supervisor, can be reached at (571) 272-1151 if attempts to reach the examiner are unsuccessful.
- The Fax number for this art unit for official faxes is (571) 273-8300.
- Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mr. Terry K. Cecil
Primary Examiner
Art Unit 1723

TKC
August 11, 2006